

### Remarks

The claims of the preceding amendment were amended to recite that the construction adhesive compositions claimed are hydraulically setting, which is evident from the entire specification. The *Eckilng* reference does not disclose or suggest hydraulically setting compositions containing cement or plaster, but rather are directed to organic polymer adhesives. *Geissler* does suggest employing his specially catalyzed dispersions in construction adhesives, but never synthesized nor suggested the synthesis of any composition claimed by Applicant, and therefore could not teach the benefits of Applicant's additives to the public.

It should be noted that most patents are improvement patents which fall within the broader disclosures of the prior art. They are nevertheless patentable. Applicant claims only a very narrow range of compositions, this range being critical to the improved performance of their additives. *Geissler* neither directs the skilled artisan to this narrow range where unexpected results occur, nor to the monomers useful in this range. One skilled in the art, in view of *Geissler*, could not possibly have derived the subject invention without the knowledge of Applicant's own disclosure. If the Office disagrees, the Office should point to those portions of *Geissler* which teach the narrow range of 0.2 to 1.5% and which teach selecting water soluble monomers having a solubility greater than vinyl acetate from among the many monomers disclosed by *Geissler*, which include many which are not water soluble at all.

The Office indicated in the Advisory Action that counsel's arguments did not address the finally rejected claims. This is incorrect. Not only were the individual references discussed fully on pages 5-9 of the response, but a discussion of Applicant's unexpected results preceded that discussion. Applicant wishes to further emphasize the importance of *In re Shaffer*, discussed on pages 8-9 of the specification. *Shaffer*, despite being an old case, is still the law. A reference which does not discuss the problem addressed cannot suggest a solution, and therefore is not an invalidating reference under 37 U.S.C. § 103.

Applicant has also discussed *Schilling*. It was noted in Applicant's response that the "cement" used by *Schilling* as an anticaking agent cannot be hydraulically settable, as it would set during spray drying of the aqueous polymer dispersions. Rather, one skilled in the art would view this term (undefined by *Schilling*) as pulverized set cement or concrete, for example that reclaimed from reconstruction sites. Settable cement, i.e. Portland cement, would not be anti-caking, but would cause caking to incur instead. At a minimum, the rejection over *Schilling* under 35 U.S.C. § 102(b) cannot be maintained since there is no certainty that hydraulically settable cement is used; rather one skilled in the art would interpret "cement" as the opposite, i.e. pulverized, previously set cement. Under inherency, the result must be the necessary and only result, not merely a possible result. *Ex parte Cyba*, 155 U.S.P.Q. 756 (P.O.B.A. 1966); *Ex parte Keith*, 154 U.S.P.Q. 320 (P.O.B.A. 1966); *Ex parte McQueen*, 123 U.S.P.Q. 37 (P.O.B.A. 1958); *Trintec Industries, Inc. v. Top-USA Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002). For this rejection to stand, not only must it be shown that "cement" in *Schilling* refers to hydraulically settable cement, but that it is present in the claimed amounts (5-80%) together with 5-80% filler (e.g. sand, crushed stone).

Neither *Schilling* nor *Geissler* anticipate, nor do they render obvious, the subject invention.

Applicants submit that the claims are now in condition for Allowance, and respectfully request a Notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the Application, she is highly encouraged to telephone Applicants' attorney at the number given below.

A check in the amount of \$1,160.00 is enclosed to cover the Petition fee of \$410.00 and the RCE filing fee of \$750.00. Please charge any additional fees or credit any overpayments as a result of the filing of this paper to our Deposit Account No. 02-3978 -- a duplicate of this paper is enclosed for that purpose.

Respectfully submitted,

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